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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,386	12/28/1999	MARIO GUILLEN	BAL6019P0090	9922
32116	7590	10/20/2004	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			HWU, JUNE	
		ART UNIT		PAPER NUMBER
		1661		

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/473,386	GUILLEN, MARIO	
<b>Examiner</b>	<b>Art Unit</b>		
	June Hwu	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 August 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 31 and 34-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 31 and 34-38 is/are rejected.

7)  Claim(s) 31 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: .

## **DETAILED ACTION**

The Request for Continued Examination filed August 6, 2004 has been received.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on August 6, 2004 has been entered.

### ***Claim Objections***

Claim 31 is objected to because of the following informalities: The term "interspecific" is misspelled and should be changed to read -- interspecific --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31 and 34-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of crossing the proprietary *Impatiens flaccida* plant disclosed on page 4 of the specification with a *I. hawkeri* Java series and selecting an interspecific plant with a trailing habit, does not reasonably provide enablement for all lines of *I. flaccida*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it

is most nearly connected, to make and/or use the invention. Enablement is considered in view of the *Wands* factors (MPEP 2164.01(a)).

The specification and declaration disclose that a single cross was made by crossing the proprietary *I. flaccida alba* with *I. hawkeri* (pages 4-5 of the specification and page 2 of Trees declaration) but does not describe whether this method of breeding an interspecific impatiens with a trailing habit will occur outside of their proprietary impatiens line. There is no known prior art that shows that viable plants were produced from crossing *I. flaccida* with *I. hawkeri*. As noted by the Applicant on page 3 of the specification, Arisumi (1980) and Arisumi (1985) all have stated that no seedling were obtained from the crossing of *I. flaccida alba* and *I. herzogii*. Since these findings have shown that no plants were recovered from crossing *I. flaccida alba* with a species of New Guinea impatiens, then one cannot assume that Applicant's own experiment would always work without Applicant's proprietary impatiens line deposited at the American Type Culture Collection. It is unclear if the proprietary line of *I. flaccida* Linda Vista breeding selection was deposited at the depositary. Since the specification is enabled for the method of using from the proprietary line, then that is what should be deposited. If the deposited *I. flaccida* line is not the same line referenced in the specification, then the claims are not enabled for any embodiment. Given the state of the prior art, the predictability in the art, the existence of working examples, guidance in the specification and the quantity of experimentation needed to make and use the invention, it would require undue experimentation for one skilled in the art to make and use the full scope of the claimed invention.

To obviate this rejection, it is suggested that the Applicant provide evidence that this method of breeding interspecific impatiens plants with a trailing habit can occur with other lines of *I. flaccida* or that the starting material as noted on page 4 is the proprietary line deposited at the ATCC.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 at step (d) is indefinite in its recitation of "an interspecific impatiens plant" because it is unclear which population of impatiens plants is selected. To obviate this rejection it is suggested that Applicant insert language that more specifically describes the resultant interspecific plants from step (c).

### ***Response to Arguments***

Applicant's arguments filed August 6, 2003 have been fully considered but they are not persuasive.

Applicant argues that that the Trees declaration state over 100 successful crossing were made between *I. flaccida* and *I. hawkeri* and that the enablement rejection was improperly applied. This argument has been fully considered, however, is not persuasive because the Trees declaration states "I have seen approximately 100 impatiens plants produced from the above-described unique interspecific cross that exhibit a trailing plant habit bred by Mr. Guillen" on page 2 at number 7. This statement reads that there was only one "unique" cross, and not over 100 crosses.

Applicant argues that the rejection based on three of the *Wands* factors is insufficient basis for the enablement rejection and that all of the *Wands* factors should be discuss. This argument has been fully considered, however, is not persuasive because again as mentioned in the previous Office action (dated February 13, 2004) all of the factors were considered and the

state of the prior art, the presence or absence of working examples, predictability or unpredictability of the art, and amount of experimentation necessary were the most relevant.

Applicant argues that the quantity of experimentation is not necessary high because there were many of successful crosses performed. This argument has been fully considered, however, is not persuasive because as stated above with reference to the Trees declaration only one cross was made with *I. flaccida* and *I. hawkeri*.

Applicant argues that the amount of direction or guidance provided by the Applicant was sufficient because two working examples were disclosed in the specification. This argument has been fully considered, however, is not persuasive because no seedlings were recovery from *I. flaccida alba* x *I. herzogii*, *I. flaccida alba* x *I. epiphytica*, or *I. flaccida alba* x *I. hookeriana* as disclosed by Arisumi (1980) and *I. flaccida alba* x 'Pele' as disclosed by Arisumi (1985). Since there were no prior art describing the nature of the invention, how to make, and how to use the invention ant no predictability of the art then the specification must explicitly state more details of the invention.

Applicant argues that there were two working examples discussed in the specification. This argument has been fully considered, however, is not persuasive because as stated above only one cross was made and two progenies were selected from that cross.

Applicant argues that the nature of the invention is not complex. This argument has been fully considered, however, is not persuasive because as stated above Arisumi (1980) and Arisumi (1985) reported no viable seedlings made from those crosses.

Applicant argues that the state of the art is mature and one of ordinary skill in the art would be able to make and/or use the invention. This argument has been fully considered, however, is not persuasive because as discussed above the prior arts did not report any viable seedlings.

Applicant argues that one of ordinary skill in the art would be able to predict the outcome of the impatiens breeding. This argument has been fully considered, however, is not persuasive because one skill in the art would not be able to repeat the same process because of the diversity between two different species will not always produce the same progenies.

Applicant argues that the breadth of the claims is not broad. This argument has been fully considered, however, is not persuasive because the progenies from the method as described may not produce a plant with a trailing habit and there are other phenotypic characteristics not disclosed.

### ***Conclusion***

No claims are allowed.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH



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